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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,764	08/10/2000	Dah-Ben Liang	36912/CM/S61	7809

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EXAMINER

SCHOEPPPEL, ROGER J

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 06/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,764

Applicant(s)

LIANG ET AL.

Examiner

Roger J. Schoeppel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/17/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-29, 31-33, 35-37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29 and 33 is/are rejected.
- 7) ☒ Claim(s) 40 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. This is to acknowledge receipt of applicants AMENDMENT AFTER FINAL ACTION filed April 17, 2003. On page 3 of that correspondence, it is stated that claims 1-4, 7-29, 31-33 and 35-41 remain in the application. This is incorrect as claim 38 was canceled in the correspondence filed February 6, 2002, and filed as Paper # 6.
2. Currently claims 1-4, 7-29, 31-33, 35-37 and 39-41 remain in the application. Claims 5, 6, 30, 34 and 38 have been canceled.
3. Applicant has filed amendments to the claims on three different filings but has not followed the required procedure for markings to support claim changes. Specifically, amendments filed September 30, 2002 as Paper #10, and April 17, 2003 as Paper # 13, along with Paper # 6, are all improperly prepared as they do not comply with Rule 1.173 and **must be refiled in a single combined form**. Rule 1.173 requires all changes involving deletions and additions must be made relative to the patent claims. According to recent practice, there should not be a clean copy submitted with the marked up copy - **only a single copy with claims which have been amended with the markings as required by Rule 1.173.**
4. Also note that as per Rule 1.173(c), all claim changes must have an indication of where the support for each change resides in the specification.
5. In applicant's filings cited as Papers #6, #10 and #13, claims 1, 4, 7, 8, 28, 29, 32 and 33 have all been amended. In resubmitting these claims in the Rule 1.173 format as abovesaid to be

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required, it is particularly significant that the issue of new matter not be inserted into the corrected claims.

6. In resubmitting claims 40 and 41, it is noted "cast" has been misspelled in each claim.

7. In the amended claim 1 in the fourth from the last line, it is suggested to change "a particle size" to --particle sizes--.

8. The revised declarations are objected to as being unclear as to specific meaning and it is required to have the coinventors refile wherein the error is more clearly defined. Specifically, it is the particles of mesh sizes in the range between 16 and 40 mesh (for example) that is to be considered, not "a particle size less than 40 mesh without also limiting such tungsten carbide particle size to a range to about 16 mesh". According to the specification, particle sizes are described in terms of micrometers not in mesh sizes. The mesh sizes only describe the particle sizes which will be retained on or will flow through certain mesh size screens. It is the "range to about" that is particularly non-descript. In refiling the declaration, it is essential that the circumstance of "No deceptive Intent" be again clearly stated.

9. Claims 29 and 33 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant regards as their invention. In claim 29, the independent claim requires the particles to be of mesh sizes between 16 and 40 mesh. Claim 29 appears to be an attempt to limit the particles to be of mesh sizes less than 40 mesh which could exceed the range of between 16-40 mesh sizes of the independent claim. The same problem occurs in claim 33 except it is with regard to greater than 80 mesh sizes. When a range is specified in an

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independent claim, a dependent claim cannot change that range if it exceeds the boundary of the preceding specified range limits or if only a portion of that range is respecified.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Roger Schoepfel whose telephone number is (703) 308-2147. The examiner can normally be reached on Monday through Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell, can be reached on (703) 308-2151. The fax phone number for this Art Unit is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

R. Schoepfel/rjs
June 24, 2003


ROGER SCHOEPPPEL
PRIMARY EXAMINER
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